

REMARKS

Claims 1 through 4 and 6 through 23 are pending in this application, of which claims 8, 10, 13, and 17 through 22 stand withdrawn from consideration pursuant to the provisions of 37 C.F.R. §1.142(b). Accordingly, claims 1 through 4, 6, 7, 9, 11, 12, 14 through 16 and 23 are active.

The specification has been amended to address a typographical oversight. In addition, claim 1 has been amended by reciting the presence of an optical guide layer formed on the active layer and by incorporating the limitations of claim 5 therein, and claim 5 cancelled. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present amendment should be apparent throughout the originally filed disclosure noting the various embodiments containing an optical guide layer formed on the active layer. Applicants submit that the present Amendment does not generate any new matter issue.

Claims 1 through 4, 6, 7, 9, 15 and 23 were rejected under 35 U.S.C. §102 for lack of novelty as evidenced by Kwak et al.

This rejection is traversed. Indeed, this rejection has been rendered moot by incorporating the limitations of claim 5 into claim 1, claim 5 not being subject to this rejection. As implicitly admitted by the Examiner, Kwak et al. neither disclose nor suggest a nitride-based semiconductor light-emitting device corresponding to that now defined in independent claim 1.

Applicants, therefore, submit that the imposed rejection of claim 1 through 4, 6, 7, 9, 15 and 23 under 35 U.S.C. §102 for lack of novelty as evidenced by Kwak et al. is not factually viable and, hence, solicit withdrawal thereof.

Claims 1 through 7, 9, 11, 12, 14, 16 and 23 were rejected under 35 U.S.C. §102 for lack of novelty as evidenced by Hata et al.

In the statement of the rejection the Examiner referred to Figs. 10 and 14 of Hata et al. and to paragraphs [0181-0186], asserting the disclosure of a nitride-based semiconductor light-emitting device corresponding to that claimed. In so doing the Examiner identified, *inter alia*, first nitride-based semiconductor layer 4, active layer 5 (Fig. 14), second nitride-based semiconductor layer 7, undoped contact layer 99, and electrode 10. This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. §102 required the identical disclosure in a single reference of each element of a claimed invention such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.* 329 F.3d 1358, 66 USPQ2d 1801 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). In rejecting a claim under 35 U.S.C. §102 the Examiner is required to specifically identify wherein an applied referenced is perceived to identically disclose each and every feature of a claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). That burden has not been discharged. Indeed, there is a significant difference between the nitride-based semiconductor light-emitting device defined in independent claim 1, which incorporates the limitations of claim 5 therein, and that disclosed by Hata et al. that scotches the factual determination that Hata et al. disclose a nitride-based semiconductor light-emitting device identically corresponding to that claimed.

Specifically, the device defined in independent claim 1 comprises, *inter alia*, an optical guide layer formed on the active layer. It is not apparent and the Examiner did not specifically

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identify, as judicially required, wherein Hata et al. disclose a device comprising, *inter alia*, an optical guide layer formed on the active layer as specified in independent claim 1.

The above argued difference between the claimed device and the device disclosed by Hata et al. undermines the factual determination that Hata et al. disclose a nitride-based semiconductor light-emitting device identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 1 through 7, 9, 11, 12, 14, 16 and 23 under 35 U.S.C. §102 for lack of novelty as evidenced by Hata et al. is not factually viable and, hence, solicit withdrawal thereof.

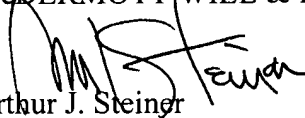
Based upon the foregoing it should be apparent that the imposed rejections have been overcome and that all active claims are in condition for immediate allowance. Favorable consideration is, therefore solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

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Respectfully submitted,

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